

## REMARKS

Applicant respectfully requests entry of the foregoing amendments and reconsideration of the application in view of the amendments above and the remarks below. Claims 1, 3-5, 7-9, 12, 15, 16, and 17 have been amended and claims 21-26 has been added, such that claims 1-26 are currently pending in the application. Claims 1, 10, 16, 25, and 26 are independent claims.

Applicant respectfully submits that no new matter has been introduced by way of the foregoing amendments. Additionally, Applicant notes that the foregoing amendments have been made as a matter of administrative convenience, and does not acquiesce to the Examiner's characterization of the claims or the cited references. Accordingly, Applicant reserves the right to pursue claims of different scope, including subject matter in the claims prior to the above amendments.

### **Examiner Interview Requested**

Applicant hereby requests that the Examiner grant his undersigned representative an in-person interview prior to the issuance of the next Office Action. Accordingly, Applicant respectfully requests that the Examiner telephone the undersigned at 703-456-8108 to schedule an in-person interview at a time convenient to the Examiner prior to the mailing of the next Office Action.

### **Claims 1-10 and 12-20 are patentable under 35 U.S.C. § 103**

Claims 1-10 and 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,260,024 to Shkedy (hereinafter "*Shkedy*") in view of U.S. Patent No. 6,070,145 to Pinsley et al. (hereinafter "*Pinsley*"). Applicant respectfully traverses this rejection for the reasons set forth below.

#### **Independent claim 1**

Independent claim 1, as amended, recites a processor-readable medium comprising code representing instructions to cause a processor to: receive transaction information related to a transaction, including consumer information and merchant information; compare consumer

information and merchant information with predetermined consumer information and predetermined merchant information, respectively; and determine whether to invite the consumer to complete a survey related to the transaction “*based at least partially on the comparison of the consumer information and the comparison of the merchant information.*”

With regard to independent claim 1, the Examiner has admitted that *Shkedy* fails to disclose or suggest determining whether to invite a consumer to complete a survey related to a transaction, for which the Examiner relies on *Pinsley*. (Final Office Action at 3.) The Examiner has argued that selecting a random user (e.g., every N<sup>th</sup> visitor), as taught by *Pinsley*, can be interpreted as making a determination of whether to invite a consumer to complete a survey based at least partially on consumer information. (Final Office Action at 11.) Although Applicant disagrees with this over-expansive reading of *Pinsley*, claim 1 has been amended for the sake of administrative convenience.

In the advisory Office Action mailed on November 8, 2004, the Examiner indicated that she did not consider the claimed code representing instructions to cause a processor to determine whether to invite a consumer to complete a survey based on a comparison of the consumer information and a comparison of the merchant information. Instead, the Examiner stated that the amendment to that claim “change[d] the scope of the claim” (advisory Office Action, Continuation Sheet) and, presumably, would require a new search.

Applicant respectfully submits that *Pinsley* does not disclose or suggest determining whether to invite a consumer to complete a survey related to a transaction “*based at least partially on the comparison of the consumer information and the comparison of the merchant information,*” as recited by independent claim 1.

Rather, *Pinsley*, at best, discloses a system that selects every N<sup>th</sup> visitor to be invited to complete a survey, based on a predetermined value of N stored as “offering criteria.” (Col. 2, lines 26-42.) *Pinsley* also discloses that a user is invited to complete a survey at the conclusion of a transaction based on “random or statistically driven pseudo-random criteria.” (Col. 4, lines 9-13.) There is no disclosure or suggestion in *Pinsley* of determining whether to invite a consumer to complete a survey based on any comparisons. Additionally, there is no disclosure or suggestion in *Pinsley* of making such a determination based on any merchant information or comparisons of merchant information.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests that the rejection of independent claim 1 be withdrawn. Additionally, for at least the same reasons, Applicant respectfully requests that the rejection of claims 2-9, which depend from independent claim 1, be withdrawn. Additionally, Applicant submits that claim 21, which depends from independent claim 1, is allowable over the cited references for at least the same reasons.

Independent claim 10

Independent claim 10 recites a processor-readable medium storing code representing instructions to cause a processor to perform a process, which includes, among other features, “instructions to cause a processor to … determine, *using the historical consumer information*, whether to collect survey information from the consumer in the transaction.”

With regard to independent claim 10, the Examiner has admitted that *Shkedy* fails to disclose or suggest determining whether to collect survey information at all. (Final Office Action at 6.) Although the Examiner has stated that *Shkedy* performs some type of determining using historical consumer information (pointing to the “credit history” disclosed in col. 10 of that document), Applicant respectfully submits that there is no discussion of making any determination using historical consumer information. To the contrary, the selection cited by the Examiner merely states that data (e.g., “credit history” data) is maintained in a database.

The Examiner has argued that it would be obvious to use the credit history of *Shkedy* to determine whether or not to collect survey information from a consumer using the system of *Pinsley*. (Final Office Action at 11-12.) As a rationale for this argument, the Examiner states that the “credit history” of *Shkedy* can be used as the “predetermined criteria” of *Pinsley*. A fair reading of *Pinsley*, however, reveals that the determination of whether to make an offer to participate in a survey is based on “random or statistically driven pseudo-random criteria” (col. 4, lines 11-13), by which the offer to participate is randomly offered to every  $N^{\text{th}}$  visitor. (Col. 2, lines 26-42.) The offer of *Pinsley* is not based on any historical consumer information, as recited in independent claim 10. Indeed, *Pinsley* teaches away from the combination proposed by the Examiner, as the selection of every  $N^{\text{th}}$  visitor in *Pinsley* would conflict with any determination based on other information, such as historical consumer information, as recited in independent claim 10.

In the advisory Office Action, the Examiner has continued to support the untenable rejection of independent claim 10, making several erroneous arguments in support of the rejection. First, the Examiner has incorrectly argued that credit history information disclosed in *Shkedy* is equivalent to historical consumer information and can be tracked according to a consumer tracking number, which is not disclosed or suggested by *Shkedy*. Second, the Examiner has incorrectly argued that the offering criteria in *Pinsley* are embedded in an information document, which is not disclosed or suggested by *Pinsley*. Third, the Examiner has incorrectly concluded that simply because information might be included in the information document of *Pinsley*, it must be trackable, which is not disclosed or suggested by *Pinsley*. Finally, based on all of the foregoing incorrect arguments and conclusions, and relying heavily on the incorrect assumption of an alleged common teaching of similar trackable information, the Examiner has incorrectly concluded that the combination of *Shkedy* and *Pinsley* renders claim 10 obvious.

Contrary to the Examiner's assertions, *Shkedy* does not disclose or suggest tracking credit history information according to a consumer tracking number. The Examiner has pointed to the "credit history" that is maintained in a buyer database, as discussed in col. 10, line 4 *Shkedy*, and has asserted that such a credit history is equivalent to the claimed historical consumer information, and has further argued that *Shkedy* discloses "developing historical consumer information for each of the participating consumers" (advisory Office Action, Continuation Sheet), which is not apparent from the text of *Shkedy*. Additionally, the Examiner has asserted that the credit histories of *Shkedy* "can be tracked according to a consumer tracking number" (advisory Office Action, Continuation Sheet); however, *Shkedy* does not disclose or suggest tracking historical consumer information according to a consumer tracking number. Rather, *Shkedy* merely discloses that information stored in the buyer database 255 can include a tracking number of a forward purchase order (FPO) 100 or a tracking number of a pooled order 110—not a consumer tracking number. In fact, the only tracking that is disclosed or suggested by *Shkedy*, represented partially by the selection cited by the Examiner, is tracking of *transactions*, and not tracking of *consumers*.

Contrary to the Examiner's assertions, the offering criteria of *Pinsley* is not embedded in an information document. The Examiner has argued that *Pinsley* discloses determining whether

to collect survey information from a consumer based on predetermined criteria, such as “consumer offering criteria.” In support of this argument, the Examiner has stated that the consumer offering criteria “is embedded in instructions into an information document,” citing the selection in col. 2, lines 3-10 of *Pinsley*. This selection of *Pinsley* merely states, however, that “[a] method for conducting a survey of users of an information document … includes embedding instructions into [the] document [which targets] the user for selection according to offering criteria.” (Col. 2, lines 3-10.) Thus, only the *instructions* of *Pinsley* are embedded in the document, and not the offering criteria themselves. Stated another way, simply because the embedded instructions target the user for selection *according to* some criteria does not indicate that those criteria are also embedded in the document.

Contrary to the Examiner’s assertion, the mere fact that information might be included in the information document of *Pinsley* does not indicate that it is trackable. The Examiner states that “since this information [presumably the consumer offering criteria] is embedded in the document, [it] is trackable, like the credit history consumer information of *Pinsley*.” (Advisory Office Action, Continuation Sheet.) As discussed above, the consumer offering criteria are not embedded in the document of *Pinsley*. Moreover, even if that offering criteria were embedded in the document of *Pinsley*, it does not logically follow that such criteria are trackable by virtue of merely being embedded. Indeed, *Pinsley* does not disclose or suggest that such consumer offering criteria are trackable.

Finally, the entire premise for combining the teachings of *Shkedy* and *Pinsley* is flawed, because the Examiner has relied on multiple erroneous arguments and conclusions about what these references teach and has provided a flawed motivation for combining these references. Specifically, for example, the Examiner argues that the teachings of these two references can be combined because they both have trackable information that can be interchanged; however, as pointed out above, neither the “credit history” disclosed by *Shkedy* nor the “offering criteria” of *Pinsley* are trackable, as the Examiner has asserted. Additionally, even if these types of information were trackable and interchangeable, as argued by the Examiner, such a combination does not disclose or suggest code representing instructions to cause a processor to determine, using historical consumer information, whether the consumer in a transaction is a participating consumer, as recited in independent claim 10.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests that the rejection of independent claim 10 be withdrawn. Additionally, for at least the same reasons, Applicant respectfully requests that the rejection of claims 12-15, which depend from independent claim 10, be withdrawn. Moreover, because *Kurland et al.*, which is used to reject claim 11, does not remedy the deficiencies of *Shkedy* and *Pinsley* discussed above with respect to independent claim 10, from which it depends, Applicant respectfully requests that the rejection of claim 11 be withdrawn. Additionally, Applicant submits that claim 22, which depends from independent claim 10, is allowable over the cited references for at least the same reasons.

#### Independent claim 16

Independent claim 16 recites a system for collecting survey information relative to a transaction between a consumer and a merchant. The system includes a monitoring interface, a processor, and a participant interface. The processor is configured to analyze the transaction record relative to stored consumer information, and is “further configured to determine whether to solicit survey information from the consumer to the transaction ***based at least partially on the transaction record and the stored consumer information.***”

*Shkedy* does not disclose determining whether to solicit survey information from a consumer, as the Examiner has admitted with regard to claims 1 and 10.<sup>1</sup> *Pinsley* also does not disclose or suggest a processor configured to determine whether to solicit survey information ***based at least partially on the transaction record and the stored consumer information.***

Rather, *Pinsley* discloses making an offer to participate in a survey at the conclusion of a transaction to every N<sup>th</sup> visitor based on “random or statistically driven pseudo-random criteria,” and not based on any transaction record. (Col. 2, lines 26-42, col. 4, lines 11-13.) Because an offer is made to every N<sup>th</sup> visitor, there is no need to store consumer information or to use consumer information or a transaction record to determine whether to solicit survey information from a consumer.

The Examiner has argued in the advisory Office Action that the number N represents an offering criteria of *Pinsley*, and that such an “offering criteria ... represents consumer

---

<sup>1</sup> The Examiner appears to have mistakenly cited a passage from *Pinsley* as if it were a passage from *Shkedy* on page 9 of the final Office Action.

information,” (advisory Office Action, Continuation Sheet) as recited in independent claim 16. However, taking the plain meaning of the claim terms “stored consumer information,” recited in claim 16, one is forced to conclude that those terms include information about a consumer that is stored. The number N disclosed by *Pinsley* is not information about a consumer. To the extent that it is considered to be information about a consumer (i.e., the order of appearance of the consumer), it does not become information about the consumer until the consumer becomes the  $N^{\text{th}}$  visitor. Thus, because the number N does not become information about a consumer until the determination (i.e., whether to make an offer to participate in a survey) has already been made, that determination cannot be based on stored consumer information because the determination has been made prior to any consumer information being available.

The Examiner has also argued that “consumers visiting the advertiser’s site represents the transaction” (advisory Office Action, Continuation Sheet). It is not clear to Applicant how this assertion relates to independent claim 16. To the extent that the Examiner intends to somehow equate this “transaction” of “consumers visiting an advertiser’s site” to the claimed “processor ... configured to determine whether to solicit survey information from the consumer to the transaction based at least partially on the transaction record and the stored consumer information,” of claim 16, Applicant strongly disagrees. Specifically, the fact that a consumer visits an advertiser’s site, does not disclose or suggest a processor configured to make a determination based at least partially on a transaction record. Moreover, *Pinsley* does not disclose or suggest making any determination based at least partially on a transaction record. Indeed, *Pinsley*, at best, indicates that a “bias” is introduced because frequent visitors to the site would be randomly selected more frequently than non-frequent visitors to the site; however, such a bias is does not suggest making a determination based at least partially on a transaction record, as the Examiner seems to intimate, but is instead based on random luck.

Accordingly, for at least the reasons discussed above, Applicant respectfully requests that the rejection of independent claim 16 be withdrawn. Additionally, for at least the same reasons, Applicant respectfully requests that the rejection of claims 17-20, which depend from independent claim 16, be withdrawn. Additionally, Applicant submits that claims 23 and 24, which depend from independent claim 16, are allowable over the cited references for at least the same reasons.

Lack of motivation to combine / teaching away of *Shkedy* and *Pinsley*

There is no motivation to combine the teachings of *Shkedy* and *Pinsley*. The Examiner has argued that the “references are combinable since they both disclose network-based systems for facilitating transactions between buyers or consumers and sellers or advertisers.” (Final Office Action at 13). The Examiner has re-iterated this overreaching argument that it would be obvious to combine any commercial, network-based systems (which would include almost every commercial website) in the advisory Office Action.

Applicant respectfully submits, however, that *Pinsley* teaches away from the combination proposed by the Examiner. Specifically, as pointed out above, *Pinsley* is directed to making an offer to participate in a survey at the conclusion of a transaction to every N<sup>th</sup> visitor based on “random or statistically driven pseudo-random criteria,” and not based on any other information. (Col. 2, lines 26-42, col. 4, lines 11-13.) Thus, one of ordinary skill in the art would not be motivated to make such an offer based on other information (e.g., the credit history information of *Shkedy*), as proposed by the Examiner, because to do so would render useless the random selection process disclosed by *Pinsley*.

Accordingly, for at least this additional reason, Applicant respectfully requests the withdrawal of the rejection of independent claims 1, 10, and 16, and their respective dependent claims.

Newly added claims 25 and 26 are allowable over references of record

Newly added independent claims 25 and 26 are allowable over the references of record for at least similar reasons to those discussed above in connection with independent claim 1. Specifically, for example, independent claim 25 recites a processor-readable medium comprising code representing instructions to cause a processor to receive transaction information related to a transaction between a consumer and a merchant, the transaction information including consumer information about the consumer participant in the transaction and merchant information about the merchant participant in the transaction; compare the consumer information with predetermined consumer information; compare the merchant information with predetermined merchant information; and determine whether to invite the consumer to complete a survey

related to the transaction based at least partially on at least one of the comparison of the consumer information and the comparison of the merchant information.

Additionally, for example, independent claim 26 recites a processor-readable medium comprising code representing instructions to cause a processor to: receive monetary transaction information, the monetary transaction information including consumer information about a consumer participant to the monetary transaction, the monetary transaction information further including merchant information about a merchant participant to the monetary transaction; compare the consumer information with predetermined consumer information; compare the merchant information with predetermined merchant information; and determine whether to invite the consumer to complete a survey related to the monetary transaction based at least partially on the comparison of the consumer information and the comparison of the merchant information.

As discussed above, neither *Shkedy* nor *Pinsley* discloses or suggests determining whether to invite a consumer to complete a survey related to a transaction based on any type of comparison, as recited by independent claims 25 and 26.

### Conclusion

All rejections having been addressed, Applicant respectfully submits that the present application is in condition for allowance, and earnestly solicits a Notice of Allowance, which is believed to be in order. Should the Examiner have any questions regarding this communication, or the application in general, she is invited to telephone the undersigned at 703-456-8108.

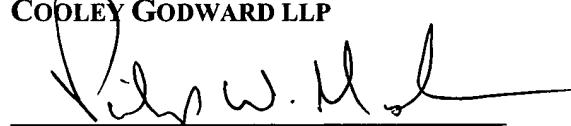
The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 50-1283.

Dated: December 8, 2004

Cooley Godward LLP  
ATTN: Patent Group  
One Freedom Square  
Reston Town Center  
11951 Freedom Drive  
Reston, VA 20190-5656  
Tel: (703) 456-8000  
Fax: (703) 456-8100

By:

Respectfully submitted,  
**COOLEY GODWARD LLP**

  
Philip W. Marsh  
Reg. No. 46,061